

REMARKS

Claims 1-3, 10-15, and 22-23 are pending in the present application. In the Office Action, claims 1-2 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1 and 13 have been amended to correct typographical errors solely to render these claims definite. The claims have in no way been narrowed by virtue of these amendments and so these amendments should not be interpreted as narrowing the claimed invention for purposes of any determination under the doctrine of equivalents.

With regard to claims 2 and 13, the Examiner alleges that the phrase "presenting the package for visual inspection by the user prior to providing the package to the user," is indefinite because it is unclear how the package can be visually inspected without first providing the package to the user. Applicant respectfully disagrees. For example, a person may hold up the package for visual inspection by the user without providing the package to the user, and then may hand, *i.e.* provide, the package to the user following the visual inspection.

For at least the aforementioned reasons, Applicant respectfully requests that the Examiner's rejections of claims 1-3, 10-15, and 22-23 under 35 USC 112, second paragraph, be withdrawn.

In the Office Action, claims 1-2, 10-11, 13-14, and 22 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald, et al (U.S. Patent No. 6,439,345) in view of Smithies, et al (U.S. Patent No. 5,647,017). Claims 3 and 15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Smithies and further in view of Stephens, et al (U.S. Patent No. 6,323,782). Claims 3 and 15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Smithies and further in

view of Keagy, et al (U.S. Patent No. 6,069,969). The Examiner's rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Recktenwald describes an item pick up system 100 that permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item when the item is not available on the sales floor or when the person must, or wishes to, pick up the item at a later time. See Recktenwald, col. 4, ll. 47-53 and Figure 1. The customer, or the customer's representative, may use a barcode scanner 200 of a kiosk 104 to scan a barcode from a sales check that was presented to the customer by a point-of-sale register attendant at the time that the customer purchased the item. See Recktenwald, col. 6, ll. 58-63. The item pick up system 100 then searches one or more databases to find the items associated with the scanned barcode from the sales check.

Recktenwald does not, however, describe or suggest the use of a two-dimensional barcode, as set forth in independent claims 1 and 13 of the present invention. Moreover, as also admitted by the Examiner, Recktenwald does not describe or suggest scanning and decoding the two-dimensional barcode to obtain the user's previously provided biometric information, conveying the user's current biometric information to the retrieval device, and, if the user's current biometric information is equivalent to the user's previously provided biometric information, providing the package to the user, as set forth in independent claims 1 and 13 of the present invention.

To remedy at least the acknowledged deficiencies of the primary reference, the Examiner cites Smithies, Keagy, and Stephens. Smithies is directed to a computer-based method and system for capturing and verifying an electronically captured handwritten signature by comparing the electronically captured signature to an encrypted signature envelope. Keagy describes using a two-dimensional barcode to encode information extracted from a fingerprint to

verify the identity of a user. Stephens describes transmitting information regarding item delivery via a radiofrequency transmission or a cell phone.

However, Applicant respectfully submits that the cited references provided no suggestion or motivation to combine the teachings of the primary reference with the teachings of one or more of the secondary references to arrive at Applicant's claimed invention. Moreover, Recktenwald appears to teach away from the Examiner's proposed modifications. In particular, the item pick up system described by Recktenwald permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item. Thus, Applicant respectfully submits that Recktenwald appears to teach away from any method of identifying the person holding the sales check. In particular, Recktenwald appears to teach away from verifying that the person holding the sales check including the scanned barcode is the person who purchased the item. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); In re Nielson, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); In re Hedges, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).*

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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